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EXAMINER

TUROCZY, DAVID P

ART UNIT	PAPER NUMBER
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1762

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/734,979
Filing Date: December 15, 2003
Appellant(s): CAMPBELL ET AL.

Anna M. Budde
For Appellant

EXAMINER'S ANSWER

MAILED
APR 25 2006
GROUP 1700

This is in response to the appeal brief filed 2/27/2006 appealing from the Office action mailed 9/30/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2001/0039324 by Sadvary et al ("Sadvary"), which incorporates Jacobs III et al., US Patent 4939213 by reference, in view of the admitted state of the art as taught by the applications description ("ASA").

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US Patent Publication 2001/0039324 Sadvary et al

US Patent 4939213 Jacobs III et al.

Admitted Prior Art as disclosed by applications description

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2001/0039324 by Sadvary et al ("Sadvary") in view of the admitted state of the art as taught by the applications description ("ASA").

*** Please note Sadvary incorporates by reference the subject matter disclosed in US Patent 5084541 by Jacobs, III et al ("Jacobs") (Sadvary Paragraph 0048)***

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Claims 1-3, 5, and 12: Sadvary teaches a film forming composition having an improved scratch resistance comprising one or more curing agents having reactive functional groups (Paragraph 0041). Sadvary discloses the curing agents include aminoplasts, isocyanates, and triazines (paragraph 0041). Sadvary teaches using a tricarbamoyl triazine or an oligomer thereof as a curing agent wherein the X is preferably oxygen and R is selected from 1 to 12 carbons in a straight chain, branched chain, alicyclic, or aromatic (See Jacobs, Column 5, lines 4-15). Sadvary discloses a triazine with an R groups containing 8 carbons (See Jacobs, example 5). Sadvary discloses spraying the thermosetting composition onto the substrate (paragraph 0089). In addition, Sadvary discloses a distinct example; see Jacobs's examples 4 and 5, which disclose a species of the claimed compound, wherein in example 5 Jacobs discloses an R group comprising a 8 carbon alkyl group.

Sadvary discloses application of a coating to a automobile (Paragraph 0003), but fails to discloses spraying in a spray booth, capturing overspray with water wash, remove water wash as waste water, and removing the compound from the waste water.

However, ASA discloses that it is known in the art to spray automobiles in a spray booth and capturing and collecting the overspray with wastewater (Paragraph 0003). In addition ASA discloses the wastewater is discharged into the sewer and then subsequently treated in a sewage treatment plant (Paragraph 0003).

Therefore it would have been obvious to one of ordinary skill in the art to modify Sadvary to include the capturing and collecting overspray with water and discharging this wastewater to the sewer as taught by ASA with the reasonable expectation of

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success because ASA discloses capturing and collecting overspray with water and discharging this wastewater to the sewer during automobile spraying and therefore would reasonably be expected to effectively provide overspray capturing and collecting the process of Sadvary.

Sadvary in view of ASA fails to disclose removing the compound of Formula I from the wastewater, however, the examiner notes, as defined by the instant

specification see paragraph 0008 and example 1, and the removal comprises removal by using a sewage treatment plant. Therefore, the prior art and the present claims, reflected by claim 1, teach all the same process steps and thus the results obtained by appellants process must necessarily be the same as those obtained by the prior art.

Therefore since Sadvary in view of ASA teach of treating the wastewater, containing the thermosetting composition as defined by Formula I, using a sewage treatment plant, it must necessarily result maximizing the capture, i.e. removal, of at least a portion of compound of formula I from the wastewater. Either 1) the appellant and the prior art have different definitions for treating the wastewater in the sewage treatment plant, or 2) the appellant is using other process steps or parameters that are not shown in the claims.

Claim 4: Sadvary discloses R may be selected from an alcohol, which comprises an oxygen atom (See Jacobs Column 5, lines 11-20).

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Claim 6: Sadvary discloses higher isocyanate such as isocyanurates are useful as curing agents (paragraph 0046).

Claim 7: Sadvary discloses R may be selected from a hexyl, octyl, 2-ethylhexyl, or any one to 12 carbon alkyls (See Jacobs, Column 5, lines 11-20).

Claim 8: Sadvary discloses the thermosetting composition as a clear-coat (Paragraph 0089).

Claims 9 and 10: Sadvary discloses a transparent topcoat composition further comprising isocyanate and hydroxyl functional material (Paragraph 0053).

Claim 11: Sadvary discloses a hydroxyl function polymer and oligomers include acrylic, polyesters, and polyurethanes (Paragraph 0054-55).

Claim 13: Sadvary discloses including the triazine curing agent in amounts of 1 to 20 percent by weight based on the total resin weight of the film-forming composition (Paragraph 0048).

Claim 14: Sadvary discloses coating an automotive vehicle (Paragraph 0003).

(10) Response to Argument

The appellant has argued against the Sadvary reference stating that the claimed subgroup possesses different features than the genus disclosed in Sadvary. The appellant argues there can be no expectation of success in random selection amount the curing agents as disclosed in Jacobs reference (incorporated by reference in Sadvary at 0048), in particular there is no appreciation of the problems with aquatic

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toxicity. The examiner respectfully disagrees. As noted in the office action dated 9/30/2005, Jacobs anticipates, in example 4 and 5, compounds included within the subgroup as claimed in claim 1 and therefore the appellant has merely observed another benefit (i.e. toxicity to aquatic life) of using the disclosed compounds in example 4 and 5. The mere observation of still another beneficial result of an old process cannot form the basis of patentability. *Allen et al. v. Coe*, 57 USPQ 136; *In re Maeder et al.* 143 USPQ 249. The examiner notes the case law cited by the appellant to defend the position as stated above, however, Jacobs exemplifies a species in the claimed subgroup and therefore the selection of a curing agent is within the scope of claim 1 and is not in fact random selection.

The appellant has argued against the Jacobs reference stating the reference fails to teach a R group containing an oxygen, however, the examiner respectfully disagrees and directs the appellants to Jacobs column 5, lines 9-18, where Jacobs explicitly discloses selecting R groups may in fact containing oxygen, for example glycol, or diethylene glycol.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

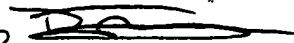
For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

David Turocy

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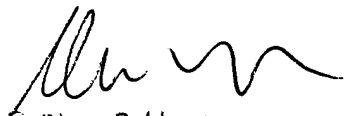
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